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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Re: **Application Serial No.:** 09/449,426
Confirmation No.: 6272
Applicants: James Meek, et al.
Title: ATM Customer Marketing System-
Docket No.: D-1119R

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated July 14, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

REJ:tcp

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D-1119R

Handwritten signature and date 8/12/03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
James Meek, et al.)	
)	
Serial No.: 09/449,426)	Art Unit: 3627
)	
Confirm. No.: 6272)	
)	
Filed: November 24, 1999)	Patent Examiner:
)	F. J. Bartuska
)	
Title: ATM Customer Marketing System)	

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**REPLY BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.193(b)**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated July 14, 2003 is acknowledged. Appellants respectfully submit that the rejections set forth in the Answer have already been addressed in the Appeal Brief.

Reply to the "Response to Argument" Section of the Answer

The Answer includes a "Response to Argument" section beginning on page 7. Appellants respectfully submit that this section of the Answer does not address all of Appellants' arguments of record. The Appeal Brief contains more reasons why the claims are allowable. Thus, please note the Appeal Brief for Appellants' additional arguments regarding all the issues of record.

Appellants respectfully disagree with the interpretation and application of the references. The Examiner's position on the issues addressed is not supported by the prior art of record. Again, please note the Appeal Brief for a more detailed discussion of the issues of record.

The anticipation by Murphy rejections

Appellants note the change of rejection as now presented in the Answer. For example, the Action (dated February 5, 2003) from which the appeal was taken asserted (at page 2) that Murphy has a first (transaction) computer (10 or 30) and a second (marketing) computer (22 or 36). The Office's latest attempt at anticipation (Answer at page 4), after viewing Appellants' arguments in the Appeal Brief, is that Murphy's computer (10 or 30) is now the marketing computer and Murphy's computer (22 or 36) is now the transaction computer. The Answer's change of rejection is reflective of the lack of legal basis for all the rejections on appeal. Regardless of how the Office changes the rejection, Murphy still cannot anticipate the claims.

The Answer's attempt to show anticipation improperly relies on what Murphy allegedly doesn't teach, rather than on what Murphy actually teaches. For example, the Answer (on page 8) states that "Nowhere in the disclosure of the Figure 1 embodiment of Murphy is it stated that the video signal is stored." Appellants respectfully disagree, as discussed in more detail hereafter. Nevertheless, Murphy does not state that the video message isn't stored. The Office cannot rely

on the absence of a particular statement in a reference as an alleged basis for a teaching contrary to the (nonexistent) statement. For further example, the Answer relies on Murphy at col. 2, lines 50-54. However, that section of Murphy merely indicates that telephone lines can be used instead of more expensive coaxial lines. Said section of Murphy does not teach that the video message transmitted via coaxial line is not stored.

Regarding advertising message display, Murphy only teaches storing the advertising message on the terminal hard disc prior to its display, no matter how the advertising message was initially transmitted from the commercial computer to the terminal. Note the storage similarities of Figures 1 and 2, particularly the transmission of the advertising data from the commercial computers (10, 30) to the terminal hard discs (18). Furthermore, in each of Figures 1 and 2 the video commercial message stored on the hard disc (18) is fed to a decoder (19) to allow the stored video message to be visually displayed on the video display unit (20) of the terminal. For example, note Murphy at col. 6, lines 39-45. Murphy teaches no other purpose for the decoder (19) of Figure 1. Thus, the Answer's statement that "Nowhere in the disclosure of the Figure 1 embodiment of Murphy is it stated that the video signal is stored" is without merit.

Murphy does not explicitly teach the recited method. The rejections are based on alleged teachings of Murphy, not factual showings of what Murphy actually teaches. That is, the record lacks substantial evidence support. The Action's assertion of anticipation is not based on any evidence in the record, especially in light of Appellants' contrary showings. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Nor does Murphy inherently teach the recited method. To establish inherency the Office must prove that the recited features are "necessarily present." Inherency may not be established based on unsupported assertions, which is the current situation. *In re Robertson*, 169 F.3d 743, 49 USPQ 2d 1949 (Fed. Cir. 1999). Again, Appellants have shown that the recited features are not "necessarily present" in Murphy.

Because Murphy stores the message on the hard disc, Murphy cannot at least teach the recited "concurrently" (e.g., claim 47) or "during" (e.g., claim 51) features. It follows that Murphy cannot teach communicating a marketing message via a second computer (and presenting the marketing message to the user) while concurrently carrying out at least a portion of a financial transaction by communicating a financial transaction message via a first computer (e.g., claim 47). It further follows that Murphy does not teach installing software (e.g., claim 55) on an automated banking machine, where the software is operative to enable communication between the machine and a marketing computer, especially during at least a portion of a financial transaction. Murphy cannot anticipate the claims.

The Murphy in view of Patterson rejections

The Answer does not address all of Appellants' arguments regarding the rejections. For example, the Answer does not address the lack of claim 1 steps (c), (e), and (f) in Murphy in view of Patterson. The Answer (beginning at page 9, last paragraph) merely attempts to explain how the (dual and independent communication) arrangement of Murphy could be modified by the (single communication) arrangement of Patterson without destroying Murphy's disclosed arrangement or operation. However, Appellants respectively disagree with the Answer's attempted explanation, as discussed in more detail in the Appeal Brief (e.g., Appeal Brief pages

15-21). Furthermore, the Answer is silent as to how Murphy could be modified to send a marketing request message (e.g., claim 1, step c) from a transaction machine to the commercial (marketing) computer (10 or 30). Additionally, neither reference teaches nor suggests using a marketing computer to select (claim 1, step e) presentation data responsive to user data sent (step c) in a marketing request message. Even the Answer asserts (at page 10, lines 5-9) that any match between customer information and a product profile would be made in a transaction computer (22 or 36). Also, Patterson teaches that the ATM (10) only communicates with the host computer (18). Patterson does not teach or suggest that the sales presentation storage (16) is a computer, especially a marketing computer. Neither Murphy nor Patterson, taken alone or in combination, disclose or suggest the recited features, relationships, and steps. It would not have been obvious to one having ordinary skill in the art to have modified Murphy with the teachings of Patterson to have produced the recited invention.

The Answer (at page 11, lines 5-10) asserts that the motivation to combine the references is based on Patterson at col. 2, lines 51-55 regarding a "best match." However, Murphy does not rely on matching. In Murphy each of the students receives the same (latest updated) locally stored advertising message (e.g., col. 7, lines 53-60). Thus, Murphy has no need of a "best match." It follows that the Answer's asserted basis for motivation to combine is without merit. Rather, the attempts to combine the teachings of the references are attempts at hindsight reconstruction based on knowledge gleaned only from Appellants' disclosure. The Answer has not established a *prima facie* showing of obviousness.

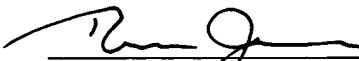
The Murphy in view of Patterson and Symonds rejections

The Answer (at page 6, last paragraph) admits that Murphy in view of Patterson does not teach or suggest "the particular message format" (i.e., an ISO 8583 marketing message format). The Action relies on Symonds as allegedly teaching the feature. The present application and Symonds were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same company, and therefore Symonds is not properly cited as prior art under 35 USC § 103(c).

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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